

REMARKS

At the time of the First Office Action dated March 19, 2008, claims 1-23 were pending and rejected in this application.

On page 2 of the First Office Action, the Examiner objected to claims 2 and 3. In response, Applicants note that claims 2 and 3 have been amended to dependent from claim 1. Applicants, therefore, respectfully solicit withdrawal of the imposed objection to claims 2 and 3.

CLAIMS 2-3 AND 15-23 ARE REJECTED UNDER THE SECOND PARAGRAPH OF 35 U.S.C. §

112

On page 2 of the First Office Action, the Examiner asserted that claims 2 and 4-12 are indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention. This rejection is respectfully traversed.

Regarding claims 2 and 3, since these claims have been amended to depend from claim 1, antecedent basis has been provided for "[t]he SLA breach value estimator." Regarding claim 15, the Examiner asserts that there is insufficient antecedent basis for the limitation "the machine." Applicants respectfully disagree. Claim 15 recites "a machine readable storage ...," and therefore antecedent basis has been provided for the term "the machine." As stated in Metabolite Labs., Inc. v. Lab. Corp. of Am. Holdings,¹ "[o]nly when a claim remains insolubly ambiguous without a discernible meaning after all reasonable attempts at construction must a court declare it indefinite." Applicants' position is that one having ordinary skill in the art would not have

¹ 370 F.3d 1354, 1366, 71 USPQ2d 1081, 1089 (Fed. Cir. 2004).

considered the phrase "the machine" to be insolubly ambiguous without a discernable meaning. Thus, the imposed rejection of claims 2-3 and 15-23 under the second paragraph of 35 U.S.C. § 112 has been overcome and, hence, Applicants respectfully solicit withdrawal thereof.

CLAIMS 1-5 ARE REJECTED UNDER 35 U.S.C. § 101

On page 3 of the First Office Action, the Examiner asserted that the claimed invention, as recited in claims 1-5, is directed to non-statutory subject matter. This rejection is respectfully traversed.

Applicants disagree with the Examiner's assertion that the claims "is nonstatutory as it does not recite any hardware elements that enable the claimed process to realize its functionality as a computer component." Initially, Applicants note that the claim is directed to a device and not a "process," as asserted by the Examiner. Moreover, a "communicative coupling" is a device and not an abstract idea as inferred by the Examiner.

Applicants also note that the Examiner requirement that a claim must recite hardware elements to enable its functionality is not a proper statement of law. In this regard, if the Examiner still believes this statement as to law to be true, Applicants respectfully solicit the Examiner to cite to a case that explicitly makes this statement. Notwithstanding the Examiner's failure to support this assertion with any case law, the Examiner is directed to the recent decision of the Federal Circuit of In re Comiskey,² which is informative as to this issue. Although the Court held that several claims were directed to non-statutory subject matter, the

² Appeal No. 2006-1286 (Fed. Cir. Sep. 20, 2007).

Court determined that other of the claims³ were directed to statutory subject matter. In determining the latter, the Court stated the following:

These claims, under the broadest reasonable interpretation, could require the use of a computer as part of Comiskey's arbitration system. (emphasis added)

Thus, the Court determined that the claims are not required to necessarily recite a computer. Instead, the Court concluded that if the claims, under a broadest reasonable interpretation, could require the use of statutory subject matter (e.g., a computer, a device, a product, etc.), then the claims meet the requirements of 35 U.S.C. § 101.

As already argued, claims 1-5 already recite statutory subject matter (e.g., communicative couplings). Moreover, since the standard, as set forth by the Federal Circuit, only requires that the claims could require statutory subject matter, and since under a broadest reasonable claim construction, the claimed service level agreement breach value estimator could include hardware, claims 1-5 meet the requirements of 35 U.S.C. § 101. Applicants, therefore, respectfully solicit withdrawal of the imposed rejection of claims 1-5 under 35 U.S.C. § 101.

CLAIMS 1-23 ARE REJECTED UNDER 35 U.S.C. § 102 AS BEING ANTICIPATED BY BETGE-BREZETZ ET AL., U.S. PATENT PUBLICATION NO. 2005/0177629 (HEREINAFTER BETGE-BREZETZ)

On pages 2-6 of the First Office Action, the Examiner asserted that Betge-Brezetz discloses the invention corresponding to that claimed. This rejection is respectfully traversed.

³ ("We consider independent claims 17 and 46 separately. They recite the use of 'modules,' including 'a registration module for enrolling' a person, 'an arbitration module for incorporating arbitration language,' and 'an arbitration resolution module for requiring a complainant [or party] to submit a request for arbitration resolution to the mandatory arbitration system.'")

The factual determination of anticipation under 35 U.S.C. § 102 requires the identical disclosure, either explicitly or inherently, of each element of a claimed invention in a single reference.⁴ Moreover, the anticipating prior art reference must describe the recited invention with sufficient clarity and detail to establish that the claimed limitations existed in the prior art and that such existence would be recognized by one having ordinary skill in the art.⁵ As part of this analysis, the Examiner must (a) identify the elements of the claims, (b) determine the meaning of the elements in light of the specification and prosecution history, and (c) identify corresponding elements disclosed in the allegedly anticipating reference.⁶ This burden has not been met.

Claim 1

Independent claim 1, in part, recites "a further communicative coupling to a user interface through which an SLA breach value estimate is proposed." On page 4 of the First Office Action, to teach the claimed "SLA breach value estimate" the Examiner identified the "network evolution planning proposal" of Betge-Brezetz. Applicants respectfully disagree.

Before making a proper comparison between the claimed invention and the prior art, the language of the claims must first be properly construed.⁷ However, the Examiner has not set

⁴ In re Rijckaert, 9 F.3d 1531, 28 USPQ2d 1955 (Fed. Cir. 1993); Richardson v. Suzuki Motor Co., 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989); Perkin-Elmer Corp. v. Computervision Corp., 732 F.2d 888, 894, 221 USPQ 669, 673 (Fed. Cir. 1984).

⁵ See In re Spada, 911 F.2d 705, 708, 15 USPQ 1655, 1657 (Fed. Cir. 1990); Diversitech Corp. v. Century Steps, Inc., 850 F.2d 675, 678, 7 USPQ2d 1315, 1317 (Fed. Cir. 1988).

⁶ Lindermann Maschinenfabrik GmbH v. American Hoist & Derrick Co., 730 F.2d 1452, 221 USPQ 481 (Fed. Cir. 1984).

⁷ See In re Paulsen, 30 F.3d 1475, 1479 (Fed. Cir. 1994); see also, Panduit Corp. v. Dennison Mfg. Co., 810 F.2d 1561, 1567-68 (Fed. Cir. 1987) (In making a patentability determination, analysis must begin with the question, "what is the invention claimed?" since "[c]laim interpretation, . . . will normally control the remainder of the

1 forth any explicit claim construction for the claimed SLA breach value estimate. Referring to
2 page 3 of Applicants' disclosure an SLA breach value, is the value against which trends and
3 violations are calculated to determine whether or not the SLA has been breached. However, the
4 SLA breach value, as recited in claim 1, is not the current SLA breach value.⁸ Instead, the SLA
5 breach value is an estimate that is being proposed.

6
7 Referring to paragraph [0003] of Betge-Brezetz, " the expression 'predicting evolution'
8 (or planning) refers to determining when and where it is necessary to integrate new plant (for
9 example a router or a new card) or to increase the traffic capacity of a link." Also, referring to
10 paragraph [0011], Betge-Brezetz teaches that "in the present context 'planning proposal' means a
11 proposal for modification (or evolution) of the network, specifying in particular action to be
12 taken on network plant and dates for the work to be carried out." Thus, the Examiner's alleged
13 teaching of "network evolution planning proposal" does not identically disclose the claimed
14 "SLA breach value estimate."

15
16 Claim 1 further recites "at least one SLA breach value estimation process selected from
17 the group consisting of an aggregated process, a specific customer process, a customer resource
18 subset process, and a predictive process," and to teach these limitations, the Examiner identified
19 paragraphs [0013]-[0015] of Betge-Brezetz. Applicants respectfully disagree with the
20 Examiner's analysis.

decisional process"); see Gechter v. Davidson, 116 F.3d 1454, 1460 (Fed. Cir. 1997) (requiring explicit claim construction as to any terms in dispute).

⁸ Claim 3 refers to a separate "current SLA breach value setting."

As best can be understood, the Examiner's cited paragraphs refer to calculating a SLA usage predictive profile (i.e., the predicted usage). However, Applicants are unclear as to where these cited passages specifically teach the claimed at least one SLA breach value estimation process. Specifically, Applicants are unclear where Betge-Brezetz specifically teaches that a breach value is estimated. Therefore, for the reasons presented above, Applicants respectfully submit that claim 1 is not identically disclosed by Betge-Brezetz within the meaning of 35 U.S.C. § 102.

Independent claims 6 and 15 recite limitations comparable to claim 1 and are patentable over Betge-Brezetz for at least the same reasons. Although the Examiner cited certain different passages with regard to claims 6 and 15 on page 5 of the First Office Action, Applicants review of these passages fail to yield any teachings of the claimed SLA breach value estimate.

Claim 2

Claim 2 recites that the estimator is disposed within an SLA builder, and to teach this limitation the Examiner cited paragraphs [0018] and [0042] of Betge-Brezetz. Upon reviewing these paragraphs, Applicants are unclear where Betge-Brezetz teaches the claimed SLA builder. Paragraph [0018] refers to a network management system and server is completely silent as to building SLAs. Although paragraph [0042] refers to generating network modification proposals, a network modification proposals is not comparable to a SLA. Thus, claim 2 further distinguishes the claimed invention over the applied prior art.

Claim 3

Claim 3 refers to a current SLA breach value setting and a proposed SLA breach value setting, and to teach these limitations, the Examiner cited paragraphs [0017], [0045], [0048], [0051], and [0066]-[0071]. Although paragraph [0048] refers to future types of service level agreements, this is not comparable to a proposed SLA breach value setting. The remaining cited paragraphs are also silent as to the claimed limitations at issue. Thus, claim 3 further distinguishes the claimed invention over the applied prior art.

Dependent claims 4 and 5 also refer to SLA breach values, and thus, these claims further distinguish the claimed invention over the applied prior art.

For above-described reasons, the Examiner has failed to establish that Betge-Brezetz identically discloses the claimed invention, as recited in claims 1-23, within the meaning of 35 U.S.C. § 102. Applicants, therefore, respectfully submit that the imposed rejection of claims 1-23 under 35 U.S.C. § 102 for anticipation based upon Betge-Brezetz is not factually viable, and hence, Applicants solicit withdrawal thereof.

Applicants have made every effort to present claims which distinguish over the prior art, and it is believed that all claims are in condition for allowance. However, Applicants invite the Examiner to call the undersigned if it is believed that a telephonic interview would expedite the prosecution of the application to an allowance. Accordingly, and in view of the foregoing remarks, Applicants hereby respectfully request reconsideration and prompt allowance of the pending claims.

Although Applicants believe that all claims are in condition for allowance, the Examiner is directed to the following statement found in M.P.E.P. § 706(II):

When an application discloses patentable subject matter and it is apparent from the claims and the applicant's arguments that the claims are intended to be directed to such patentable subject matter, but the claims in their present form cannot be allowed because of defects in form or omission of a limitation, the examiner should not stop with a bare objection or rejection of the claims. The examiner's action should be constructive in nature and when possible should offer a definite suggestion for correction. (emphasis added)

To the extent necessary, a petition for an extension of time under 37 C.F.R. § 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 09-0461, and please credit any excess fees to such deposit account.

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